

REMARKS

In the Office Action mailed February 9, 2007 from the United States Patent and Trademark Office, the Examiner rejected claims 1, 4, 5, 8, 10, 29, 33, 35-38, and 46-48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,124,094 to Kobayashi et al. (hereinafter “Kobayashi”). The Examiner also rejected claims 7 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of U.S. Patent No. 6,618,566 to Kurijai et al. (hereinafter “Kurijai”), rejected claims 8 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of U.S. Patent No. 6,385,675 to Yamaguchi (hereinafter “Yamaguchi”), rejected claims 11-13 and 39-41 under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of Applicant’s specification, and rejected claims 14, 16, 18, 20, 21, and 42-45 under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of U.S. Patent No. 5,602,974 to Shaw, (hereinafter “Shaw”). Accordingly, Applicant respectfully provides the following:

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicant respectfully submits that the references cited by the Examiner, alone or in combination, do not teach or suggest the limitations claimed in the present claim set. Furthermore, Applicant respectfully submits that there is no motivation to combine references in

the manner suggested by the Examiner found in the references themselves, but that the proposed motivations are based on hindsight reasoning using Applicant's disclosure.

Independent claim 1 requires: receiving a request from a user to render a print job; spooling data of the print job to a spooler . . . using a print subsystem component to authenticate the user and an account of the user, . . . using the print subsystem component to parse the spooled data and determine a layout and a number of pages of the print job; using the print subsystem component and the parsed data to determine a cost for consumables to render the print job, wherein the cost for consumables is determined prior to despooing print data of the print job to the printing device; using the print subsystem component to determine an amount of available funds in the user's account; and if the amount of available funds exceeds the cost for consumables, using the print subsystem component to debit the cost of the print job from the user's account and rendering the print job at the printing device." Applicant respectfully submits that Kobayashi does not teach these claim limitations.

Kobayashi teaches a specialized system to permit billing for royalties connected with printing a copy of a copyrighted work, based in part on detecting and reporting a successful print outcome. (See Background of the Invention, especially Col 2 lines 4-18 and Col 3 lines 18-22, for example.) Kobayashi therefore teaches a detailed tracking and billing system. However, the system disclosed by Kobayashi fails to teach all limitations of claim 1 set forth above.

Specifically, claim 1 requires "using the print subsystem component to parse the spooled data and determine a layout and a number of pages of the print job." In the Office Action, the Examiner relied on Column 18, lines 35-51 as teaching this limitation. Applicant respectfully disagrees. Nothing in the cited passage indicates that any parsing of spooled data is being performed. Instead, the cited passage deals with the data server 10 holding back on sending too

much textual information to the printer client 40 (a computer device illustrated in Figure 6).

Kobayashi specifically teaches that the data server does not perform the printing but merely stores textual data and sends the data as encrypted text to the printer client computer device.

(See Col 21 lines 1-11.) Therefore, in the cited passage on which the Examiner has relied, when the disclosed dividing of textual data occurs, the division is not performed on spooled data as is required by claim 1, but is performed on a textual file only. Therefore, this limitation of claim 1 is not taught by Kobayashi.

Claim 1 also requires “using the print subsystem component and the parsed data to determine a cost for consumables to render the print job, wherein the cost for consumables is determined prior to despooling print data of the print job to the printing device.” As is clear from this limitation, the claim requires that the limitation be performed after the data is spooled to a spooler (in that the parsed data obtained from the spooled data is used) and before the data is despoled to the printing device. This determination of the cost of consumables is clearly not taught by Kobayashi. In the Office Action, the Examiner relied on Figure 7, step S15 as teaching this limitation. However, the preparation of an estimate of the cost of the print job illustrated in step S15 of Figure 7 clearly shows that the estimation of Kobayashi occurs long before any spooling of the print job has occurred and does not use spooled data. As is taught by Kobayashi, the first spooling and despooling only occurs at step S30 of Figure 7, long after any estimation of the cost of the print job has occurred. (See Col 24 lines 10-14, and Col 22 lines 28-32.) Therefore, Kobayashi clearly cannot teach the claimed limitation of determining the cost for consumables using the print subsystem and the parsed spooled data before despooling to the printing device.

Furthermore, claim 1 requires “using the print subsystem component to determine an amount of available funds in the user’s account; and if the amount of available funds exceeds the cost for consumables, using the print subsystem component to debit the cost of the print job from the user’s account and rendering the print job at the printing device.” Kobayashi does not teach these limitations. In the Office Action, the Examiner relied on Kobayashi’s teaching that a credit or debit card can be used for payment for the printing, citing column 41 lines 30-31. Applicant does not dispute that Kobayashi teaches paying using a credit or debit card. However, the Examiner’s rejection fails to understand Kobayashi’s payment system in comparison with Applicant’s claimed method. Applicant’s method requires determining an amount of available funds and whether the amount of available funds exceeds the cost for consumables before rendering the print job. In this way, Applicant’s method ensures that payment is received before a print job is rendered. Kobayashi’s system is completely different, as may be seen by reference to Figure 7 that was cited repeatedly by the Examiner. As may be seen from Figure 7, no reference to payment is made between the steps of providing a payment estimate at step S15 and payment charging at step S33; however, step S33 clearly occurs after printing has been completed. (See Col 24, lines 29-33.)

Kobayashi makes it abundantly clear that the payment process only occurs after printing has been completed, as Kobayashi describes in detail how all payment, including specifically using a debit card, is intended to work.

When printing of image data is terminated in step 109, printing result information (D) is transmitted to service system S, and charge calculation section 149 calculates printing charges for image data based on charges relating to an offer of image data and on printing results. Calculation of printing charges for image data can also be conducted on the service system S side from the transmitted printing result information (D). In step 111, printing charges for image data are printed to be issued as a receipt, and further, when a dealer owning image forming apparatus 101 conducts account-deduction for charges, printing charges are deducted from a

bank account through communication network 129 for the payment charging process, based on charge payment information (C), when a debit card, for example, is used as a payment method. . . . Since printing charges in a BOD mode are calculated based on information of charges relating to an offer of image data, charges relating to image data of copyright are calculated for certain. Further, when occurrence of printing error such as a sheet jam is detected, the charges are discounted for calculation, because printing charges are calculated based on the results of printing. Therefore, printing charges relating to image data such as copyright are surely collected, and wrong charges caused by printing error are not requested to a user, thus, efficient calculation of printing charges can be made.

(Col 64 lines 24-53, emphasis added; refer also to Figure 19.) This passage also makes clear how Kobayashi's post-billing system is designed to handle the specific problem of billing for printing of a copyrighted work, but only if printing is successful. Thus, a proper understanding of Kobayashi makes perfectly clear that no reference to a debit card's balance or charging of the payment amount is made before printing is completed. (See Figures 7 and 19) For this reason, the Examiner's reliance on the teaching of the user of a debit card for payment post printing cannot be said to teach applicant's claimed limitations of determining "an amount of available funds in the user's account; and if the amount of available funds exceeds the cost for consumables, using the print subsystem component to debit the cost of the print job from the user's account and rendering the print job at the printing device."

For all these reasons, Applicant respectfully submits that Kobayashi does not make the invention claimed in claim 1 obvious. Claim 29 contains similar limitations and is allowable for similar reasons. All other claims depend from one of claim 1 and claim 29 and are therefore also allowable. Applicant therefore respectfully requests removal of the rejections of claims 1, 4, 5, 8, 10, 28, 33, 35-38, and 46-48 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi.

Regarding the separate rejections of the dependent claims relying on combinations of Kobayashi and other references, Applicant respectfully submits that none of the other cited references teach the claim limitations discussed above, either alone or in combination with

Kobayashi. For this reason alone, Applicant respectfully requests removal of the rejections of all other dependent claims under Section 103. Applicant further directs the Examiner to Applicant's contentions regarding the lack of a motivation to combine references in Applicant's previous response, rather than restate those arguments in detail here.

Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein is not made obvious by the references cited by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

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Respectfully submitted,

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